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| In re Application of | : | |
| BERNSTEIN, et al. | : | DECISION ON PETITION |
| U.S. Application No.: 09/806,657 | : | |
| PCT No.: PCT/GB99/03274 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 04 October 1999 | : | |
| Priority Date: 07 October 1998 | : | |
| Attorney's Docket No.: 704032-1P/US | : | |
| For: NAPHTHALENECARBOXAMIDES AS | : | |
| TACHYKININ RECEPTOR ANTAGONISTS | : | |

This decision is in response to applicant's "Petition to Revive Under MPEP 711.03" filed 29 May 2001 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a petition for revival pursuant to 37 CFR 1.137(b). The petition fee of \$1240.00 has been provided.

BACKGROUND

On 04 October 1999, applicant filed international application PCT/GB99/03274, which claimed priority of an earlier application filed 07 October 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 13 April 2000. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 April 2001.

On 30 March 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by an executed oath or declaration of the inventors as required by 35 U.S.C. 371(c)(4); a copy of the International Application as filed; an Information Disclosure Statement; an assignment document for recording and a First Preliminary Amendment. Applicant did not provide payment of the full U.S. Basic National Fee.

On 18 May 2001, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) indicating that applicant had failed to provide the full U.S. Basic National Fee by 30 months and that the application was abandoned as to the United States of America.

On 29 May 2001, applicant filed the present petition accompanied by authorization to charge the national fees and petition fee to Deposit Account No.: 26-0166.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional." and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the required reply is the payment of the Basic National Fee under 37 CFR 1.492(a). Applicant has authorized the deduction of this payment from Deposit Account 26-0166.

As to Item (2) the appropriate petition fee of \$1240.00 as required by 37 CFR 1.17(m) has also been authorized to be deducted from Deposit Account No.: 26-0166.

With regard to Item (3), applicant's statement that, "the entire delay up to the filing of this petition was unintentional" is being interpreted to mean that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. If this is an incorrect reading of applicant's statement applicant should contact the PCT Legal Office immediately. Applicant's statement and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

It is noted that the fifth inventor is listed as Scott Alan SHEWOOD in the published international application and Scott Alan SHERWOOD on the executed declaration filed 30 March 2001. This raises the question as to whether this discrepancy is the result of a typographical error or a name change. In order to continue processing of the application applicant is required to provide an explanation for this discrepancy. If the discrepancy is the result of a name change, a petition under 37 CFR 1.182 is required. See MPEP 605.04(c) for further requirements.

CONCLUSION

Applicant's petition for revival pursuant to 37 CFR 1.137(b) is **GRANTED**.

As authorized, \$1644.00 will be deducted from Deposit Account 26-0166. (\$1364.00 for payment of the basic national fee, \$40.00 assignment recording fee and \$1240.00 for the 37 CFR 1.137(b) petition fee.

Applicant is hereby afforded **TWO MONTHS** from the mail date of this decision to furnish the proper reply as indicated above. Failure to file the reply within the time period provided will result in abandonment. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office



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